



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/315,796	05/20/99	DAVIS	B WILL-2501

ROBERT HARDY FALK
FALK & FISH LLP
700 NORTH PEARL STREET
SUITE 970 LB 366
DALLAS TX 75201

MM21/0208

EXAMINER

FUNK, S

ART UNIT

PAPER NUMBER

2854

DATE MAILED:

02/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/315,796

Applicant(s)
Davis et al.

Examiner
Stephen R. Funk

Group Art Unit
2854



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-87 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-87 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The patent sought to be reissued by this application is involved in litigation. Any documents and/or materials, including the defenses raised against validity or against enforceability because of fraud or inequitable conduct, which would be material to the examination of this reissue application are required to be made of record in response to this action.

A protest to request suspension of reissue proceedings has been filed under 37 C.F.R. § 1.291(a) on 9/15/99, and a copy has been served on applicant.

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because a stay of that litigation is in effect for the purpose of awaiting the outcome of these reissue proceedings. Note the Order Granting Motion to Stay on 7/6/99 in Paper No. 6 Exhibit E.

Insofar as the Protest raises questions of inventorship there has been no evidence submitted by the Protestor to warrant any rejections under 35 U.S.C. §102(f) and/or (g).

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The reissue oath or declaration filed with this application is defective because:

It must identify each inventor by full name, and each inventor's residence, post office address and country of citizenship as required by 37 C.F.R. § 1.63(a)(3). See M.P.E.P. § 1414 and 37 C.F.R. § 1.175(a).

Additionally, the oath or declaration must state that all errors being corrected in the reissue application "up to the time of the filing of the oath or declaration" arose without any deceptive intention on the part of the applicant as required by 37 C.F.R. § (a)(2).

It is further noted that applicant has provided what appears to be a total of three separate declarations, "Reissue Declaration", "Declaration and Power of Attorney", and "Application for Reissue of U.S. Patent 5,630,363 under 35 U.S.C. § 251 and 37 C.F.R. § 1.171" and incorrectly utilizes the terminology "sole inventors" in the "Reissue Declaration". It is suggested that applicant provide all of the required information in a single oath or declaration so as to quickly advance prosecution and avoid redundancy and confusion.

Claims 1 - 87 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251. See 37 C.F.R. § 1.175.

Applicant is reminded that if any additional amendments are made to the specification, drawings, or claims, a new/supplemental oath or declaration complying with 37 C.F.R. § 1.175(a)(1), (a)(2) and/or (a)(3), (a)(5), (a)(6), and (a)(7) is required.

The disclosure is objected to because of the following informalities: In column 3 line 59 "flexo" should presumably be --flexographic--. In column 4 lines 46 - 49 it appears that the liquid vehicle is applied directly to the impression cylinder per se, not the substrate on the impression cylinder. In claim 57 line 3 "flexography" should presumably be --flexographic--. In claim 78 line 1 "77urther" should be corrected. Appropriate correction is required.

Claims 12 - 14, 19, 21, 22, 52, 54 - 57, 62, 64, 65, and 86 are objected to under 37 C.F.R. 1.75(a) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12 subparagraph (4) it appears that the liquid coating image is applied directly to the impression cylinder per se, not the substrate on the impression cylinder. Note also new

claims 52, 54, and 55.

In claims 19, 21, and 22 it is not clear if the recitations of "colored ink images" refer to the "flexographic color ink image" recited in claim 17 subparagraph (1) or the "additional colored ink images" recited in claim 17 last paragraph. Note claims 18 and 20 for comparison. The terminology should be consistent among the claims. Note also new claims 62, 64, and 65 and, accordingly, claims 61 and 63 for comparison.

In claim 57 lines 2 - 3 "said impression cylinders" lacks any clear antecedent basis as the recitation "at least one" in claim 55 line 7 only positively sets forth one station. This could be corrected by deleting "of" in line 2 and making "cylinders" singular in line 3 which still recites that each and every impression cylinder has an air dryer.

In claim 86 subparagraph (3) "said flexographic materials" lacks any clear antecedent basis.

Claims 49 - 79 and 82 - 87 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 depends from claim 44 but appears to be drafted as an independent claim. Accordingly, all of the structure recited in claim 49 would be a double recitation of the same in claim 44.

In independent claims 44, 53, 55, 58, 60, 72, 82, and 86 the terminology of applying "thin, controlled layers" to the substrate has no clear meaning. It is noted that in each of these claims applicant afterwards recites that "images" are printed with the "thin, controlled layers".

Accordingly, it is not apparent how these recitations differ in scope.

In claim 85 line 2 it is recited that the method combines offset lithography and flexography but there is no specific recitation of printing by flexography in the body of the claim. Accordingly, it is not clear if the method encompasses a combined printing process or not.

In claim 87 lines 7 - 8 it is recited that inks, coatings, "and" slurries are deposited on the substrate but in line 9 it is recited that inks, coatings, "or" slurries may be printed on the substrate. Accordingly, it is not clear if the apparatus prints all three materials or any of the three materials. This claim will be examined with respect to the prior art as if any of the materials are applied since this interpretation more closely corresponds to the specification.

Claims 42 - 87 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

First, in each of independent claims 44, 53, 55, 58, 60, 72, 80 - 82, and 85 - 87 and dependent claims 42, 43, and 49 the recitations of printing on "both sides, opposite sides, or the reverse side" of the substrate is not supported by the original disclosure. Other than the brief mention of perfecter printing in column 2 lines 54 - 55 with respect to prior art sheet fed presses there is no other discussion of perfecter printing or printing on opposite, both, or the reverse side of the substrate in the original disclosure. Furthermore, the terms "over" and "on top of" are used interchangeably in the specification and in no instance is it implied that sometimes the

term "over" refers to perfector printing. Specifically, the meaning of the term "over" in context in column 4 lines 29 and 43 (applicant's declaration incorrectly refers to column 5) is no different than the context meaning of "over" in column 4 line 38 (again the declaration incorrectly refers to column 5) and column 6 line 3. Applicant's apparent argument that the use of this term with "overcoating" in the latter two instances clearly implies on the same side of the substrate but the first two instances of "over" with reference to "color images" implies perfector printing is without merit and self serving. Note original claims 29 and 34 in the parent application and column 7 lines 52 - 60 which state that additional "colored ink images" are printed "on top of" the previously printed image, thus, referring to printing on the same side of the substrate which contradicts applicant's assertion. Additionally, the use of the term "over" does not have any connotation of perfector printing in the art without being first preceded by "turning" or "flipping" and only with specific reference to the substrate. Lastly, the Declaration of Raymond J. Prince provides no objective evidence that the term "over" can refer to perfector printing and none of the exhibits provided in this declaration use the term "over" with respect to perfector printing.

Second, in independent claims 44, 53, 55, 58, 60, 72, 82, and 86 the terminology of applying "thin, controlled layers" to the substrate has no support in the original disclosure and, furthermore, has no clear scope or meaning.

Claims 42 - 87 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 6, 9 - 20, 22 - 25, and 28 - 38 are rejected under 35 U.S.C. 102(e) as being anticipated by DeMoore et al. (US 5,960,713). DeMoore et al. is ultimately a CIP of S.N. 08/435,798 which has a filing date of 5/4/95. While this patent is a CIP of the earlier application, and could contain subject matter not disclosed in that application, reference can presently be made to EP 741,025 which claims direct priority from S.N. 08/435,798. All references to Demoore et al. will be made to EP 741,025.

DeMoore et al. teach a first flexographic station (22, 110) for printing either colored inks, white ink, metallic particles, an encapsulated essence, or aqueous or UV coatings on a sheet or web (col. 2 lines 40-45, col. 3 lines 17-21, col. 4 lines 32-35, col. 9 line 47 - col. 10 line 18) and at least one successive lithographic station (24-28) for printing colored inks, aqueous, or UV coatings (col. 4 lines 32-50 and col. 10 lines 19-27). Applicant should carefully

review the entire document of DeMoore et al. With respect to the flexographic plate, plate cylinder, blanket cylinder, and anilox roller see column 10 lines 4 - 11. With respect to successive flexographic stations see column 6 lines 21 - 27. With respect to the air dryer see column 9 lines 1 - 10. With respect to the waterless inks see column 3 lines 21 - 30 and column 10 lines 19 - 27. With respect to claim 22 the plates would inherently be either solid or halftone.

Claims 7, 8, 21, 26, 27, and 39 - 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeMoore et al. With respect to the size of the metallic particles it would have been obvious to one of ordinary skill in the art to use uniform sized particles to achieve a uniform, flat printed image or non-uniform sized particles to achieve a desired textured appearance. With respect to claim 21 it is widely conventional in the art to make halftone lithographic printing plates to achieve superior image appearance. With respect to claim 39 it would have been obvious to one of ordinary skill in the art to overprint the same image with the same color ink to simply achieve a denser or more opaque color. With respect to the added claims, insofar as they are adequately supported by the original disclosure, DeMoore et al. teach in column 3 lines 17 - 19 that the substrate may be printed on either side. It would have been obvious to one of ordinary skill in the art to selectively print on both sides of the substrate so as to achieve desirable perfector printing.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In particular note the patents to Wolff (US 3,072,050), Bird (US 4,796,556) and (US 4,841,903), and Koehler et al. (US 5,178,678).

Applicant's amendments to the specification and prior art are deemed to be merely typographical errors and are accepted without additional comment. The amendments to claims 29 and 34 are not deemed to change the scope of the claims as "over" and "on top of" are used interchangeably in the original disclosure and are considered to have the same meaning. Accordingly, there is no objection to these claims as the scope, for purposes of examination, has not changed.

A shortened statutory period for response to this action is set to expire **ONE MONTH** from the date of this letter.

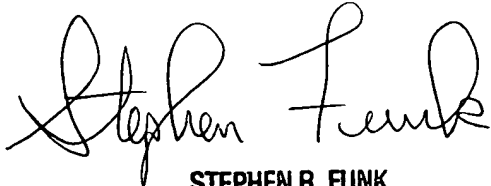
Due to the related litigation status of this reissue application, extensions of time under the provisions of 37 C.F.R. § 1.136(a) will **NOT** be permitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk whose telephone number is (703) 308-0982. The examiner can normally be reached on Monday - Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hilten, can be reached at (703) 308-0719. The fax number for incoming official papers is (703) 308-7722, 7724. The fax number for informal papers in Art Unit 2854 is (703) 308-5841.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Stephen Funk
February 3, 2000


STEPHEN R. FUNK
PRIMARY EXAMINER